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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,564	04/07/2000	Paul Germeraad	1531.0310001	1827

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

GM

# Office Action Summary

Application No.  
09/545,564

Applicant(s)  
Germeraad et al.

Examiner  
Jean M. Corrielus

Art Unit  
2172



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 18, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-34 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. This office action is in response to the preliminary amendment filed on 7/18/01 (paper no.5) in which claims 2-34 were added and claim 1 was canceled.

### ***Related Applications***

2. The applicant is advised to provide the serial number and the statuses of the patent application cited in the "cross Reference to Other Applications" section in pages 1-3 of the specification.

### ***Claim Objections***

3. Claims 3, 10, 18, 20 and 27 are objected to because of the following informalities: the acronym "SIC" in the claims is not proper. Applicants are suggested to spell out the aforementioned acronym in the claims. Appropriate correction is required.

### ***Information Disclosure Statement***

4. The information disclosure statement filed on 05/16/01 (paper no.4) complies with the provisions of M.E.P.. § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits

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***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 2-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-32 of co-pending U.S. Patent application serial No.09/564, 828. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: Claim 1 of the instant application substantially recites the limitations of claim 1 of the cited co-pending U.S. patent application. The claim merely

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omits certain the underlined limitations the research and development project and replaces the bolded limitations **the process of licensing the subject matter**.

It would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the cited steps as indicated claims 2, 17 and 18 of the co-pending patent application since the omission and addition of the cited limitations would have not changed the process according to which the method for facilitating the process of licensing subject matter. Specifically, the ordinary skilled artisan would have been motivated to modify claims 2, 17 and 18 of the cited co-pending patent application by replacing **the process of licensing the subject matter** with research and development project. The cited substitute elements would not interfere with the functionality of the steps previously claimed and would perform the same function of transmitting images and other objects over a computer network system. In re Karlson, 136 USPQ 184 (CCPA 1963).

*Claims 3-17 and 20-34 of the instant application substantially recites the limitations of claims 3-16 and 19-32 of the cited co-pending U.S. patent application. They are, therefore, rejected under the same rationale.*

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***Claim Rejections - 35 U.S.C. § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (hereinafter "Unger") US Patent no.5, 721,910 in view of Narin et al (article entitled "Technological performance assessments based on patent and patent citations").

As to claim 2, Unger discloses a database design (which is a tool), wherein Unger discloses the claimed "accessing a tool box comprising a plurality of tools wherein each of said tools is associated with one or more tasks of stages of the research and development project" as a means for accessing the database Spreadsheet tool, wherein the spreadsheet is associated with six tasks of stages of the research and development project (Fig.1; col.5, line 7-col.6, line 44), wherein the database is a tool

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use to access the subject matter; “selecting a task associated with one or more of the stage of the research and development project” as a stage III through VI that represent the database design, wherein stage III represents the electronic capture of Patent Abstracts (col.5, lines 7-15); “invoking a tool from said tool box applicable to said selected task” as an enhancement represented by the current invention is that these detailed analyses can then be electronically linked to a given patent (col.5, lines 10-13); and “performing said selected task using said invoking tool” as a means for electronically displaying along with the patent abstract the detailed analyses of the given patent (col.5, lines 13-16). However, Unger does not explicitly disclose the use of a the research and development project.

On the other hand, Narin provides interesting marketing and licensing capability and licensing analyses, wherein the focus is upon the patents as a measure of technological dominance or process (page 174, col.2).

It would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify Unger’s system, wherein the spreadsheet, provided thereof (see Unger’s fig.1) would provide the use of licensing process, in the same conventional manner as suggested by Narin (page 174, col.2).The motivation being to measure the effectiveness and productivity of the vast scientific establishment.

As to claims 3, Unger discloses the claimed “invoking a tool for generating a map, wherein said map displays patent information that identifies related materials process” (col.7, lines 10-13).

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As to claims 4-10, Unger and Narin disclose substantially the invention as claimed. In addition, Narin discloses the use an inventorship (page 176), wherein the inventors is identified those who have worked in an area pertaining to an idea of a user company (page 176, 178) and the use of technology classification (page 176-177).

As to claims 11-17, Unger and Narin disclose substantially the invention as claimed. In addition, Narin discloses the use of generating a patent count per year (page 178), assignee (page 175), patent citation (page 173) and generating a patent/ month to issue (page 178).

As to claims 18-34:

The limitations of claims 18-34 have been noted in the rejection of claimed 2-17 above. They are, therefore, rejected under the same rationale.

### ***Conclusion***

9. Any inquiry concerning this communication or early communication from the Examiner should directed to Jean Corrielus whose telephone number is (703) 306-3035. The Examiner can normally be reached on the weekdays from 7:00am to 5:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, *Kim Vu*, can be reached on (703)305-9343.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231 or faxed to:

Serial Number: 09/545,564:

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(703) 746-7239, (for formal communications intended for entry) Or: (703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).



Jean M. Corrielus

Patent Examiner

November 13, 2001